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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/400,034 09/21/99 ITO

R OLYMPUS-13

026479  
STRAUB & POKOTYLO  
1 BETHANY ROAD, SUITE 83  
BUILDING 6  
HAZLET NJ 07730

IM22/0817

EXAMINER

SAVAGE, M

ART UNIT	PAPER NUMBER
	1723

DATE MAILED: 08/17/01

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

## Office Action Summary

Application No.

09/400,034

Applicant(s)

ITO, RALPH K.

Examiner

Matthew O Savage

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1723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1) Responsive to communication(s) filed on \_\_\_\_.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

4) Claim(s) 1-52 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_ is/are allowed.

6) Claim(s) \_\_\_\_ is/are rejected.

7) Claim(s) \_\_\_\_ is/are objected to.

8) Claim(s) 1-52 are subject to restriction and/or election requirement.

### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

1) Notice of References Cited (PTO-892)

4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_.

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

5) Notice of Informal Patent Application (PTO-152)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.

6) Other: \_\_\_\_.

This application contains two patentably distinct species of tip aliquot supports that correspond to the drawing Figures as follows: species 1 corresponding the FIG.2; species 2 corresponding to FIG.8.

This application contains claims directed to the following patentably distinct species of the claimed invention:

Claims 1-44 correspond to species 1;

Claims 45-52 correspond to species 2.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record

showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

The following election requirement applies in the case that species 1 is elected:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-10, drawn to an apparatus for preparing a fluid sample, classified in class 422, subclass 100.
- II. Claims 11-13, drawn to a method of preparing an aliquot, classified in class 422, subclass 180.
- III. Claims 14-20, drawn to a sample aliquot pipette tip, classified in class 422, subclass 100.
- IV. Claims 21-27, drawn to a tip aliquot support, classified in class 422, subclass 100.
- V. Claims 28-39, drawn to a system for preparing an aliquot, classified in class 422, subclass 63.
- VI. Claims 40-43, drawn to methods of preparing an aliquot, classified in class 436, subclass 48.

Inventions V and (I, III, and IV) are related as combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination as

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claimed does not require the particulars of the subcombinations as claimed for patentability, and (2) that the subcombinations have utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of claims 2-10 of group I, claims 15-20 of group III, and claims 22-27 of group IV of the subcombinations. The subcombinations have separate utility such with a manually operated pipetting system.

Inventions groups (II and VI) and (I, III, V, and IV) are related as processes and apparatuses for their practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatuses could be used to carry out another and materially different process, for example, in a process for temporarily sealing liquid dispensor including placing liquid in a container, connecting the pipette tip to the container, dispensing liquid from the container through the pipette, and then, temporarily sealing the pipette tip with the constricted passage.

Groups I, III, and IV would be examined in the same application.

The following election requirement would apply in the case that species 2 is elected:

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VII. Claims 45-47, drawn to an apparatus for preparing a fluid sample, classified in class 422, subclass 100.

VIII. Claims 48-52, drawn to a tip aliquot support, classified in class 422, subclass 100.

Inventions VII and VIII are related as combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of claims 49-52 of the subcombination. The subcombination has separate utility such as a nozzle for a flow line.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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Any questions regarding this communication should be directed to Matthew Savage on 703-308-3854 between the hours of Monday-Friday from 7:00 am to 3:30 pm. The Group 1700 fax numbers are 703-872-9310 for regular responses, and 703-872-9311 for after final responses.

*M. Savage*  
**Matthew Savage**  
**Primary Examiner**  
**Art Unit 1723**

August 1, 2001